

REMARKS

Claims 3, 10, 11, and 13 were cancelled without prejudice or disclaimer. Claims 2 and 9 are in original form and claims 1, 4-8, 12, and 14-22 were previously presented. New claims 23-26 have been added. Claims 1-2, 4-9, 12, and 14-26 are currently pending. Reconsideration of the pending claims in view of the following remarks is respectfully requested.

Applicant's representative thanks Examiner Nicholson for courtesies extended in a phone interview conducted on May 19, 2008 in which claims 1 and 16 were briefly discussed. The details of the interview are discussed with respect to the above claims in the remarks below.

DRAWINGS

The drawings and in particular FIG. 5 has been amended to identify the slice by the adding reference character 35. A replacement sheet accompanies this Amendment reflecting such change. The specification has been amended accordingly.

ABSTRACT

The Office Action stated that the Abstract of the disclosure is objected to because it is not descriptive of what Applicant regards as new in the art to which the invention pertains. Applicant believes the Amendment to the Abstract corrects such deficiency and a notice to that effect is respectfully requested.

GUIDELINES TO THE SPECIFICATION

The Office Action objected to the specification for failing to provide heading for each

section. Applicant believes that the Amendment to the Specification corrects such deficiency by adding the appropriate headings and a notice to that effect is respectfully requested.

REJECTION UNDER 35 U.S.C. § 112

The Office Action stated that claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, stating that claim 16 recites the limitation “slice” in parts e) and f) and that there is insufficient antecedent basis for the limitation in the claim. Applicant has amended both the drawings and specification to further identify the “slice” and notes that claim 16 part e) states “a slice”. Accordingly, claim 16 is believed to be definite and a notice to that effect is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102(b)

The Office Action stated that claims 1-2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,015,565 to Berge (hereinafter “Berge”). Claim 1 features a medical protection sheeting formed from a low frictional material having a coefficient of static friction substantially the same as its coefficient of dynamic friction, and wherein the material is woven. Claim 1 was briefly discussed during the interview, however, no agreement was reached regarding its allowability.

Berge fails to anticipate claim 1 as “[a] claim is anticipated only if each and every element as set forth in the claim is found.” *Verdegaal Bros. v. Union Oil Co.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). There is no teaching or suggestion in Berge of a medical protection sheeting formed from a low frictional material having a coefficient of static friction substantially

the same as its coefficient of dynamic friction. In fact, Berge teaches that the material or fabric used is desirably made from high friction material. *See for example*, Col. 1, Lines 63-68, stating “[t]he tubular mat is uniquely constructed of flexible material which preferably has a tough wear-resistant exterior surface engageable with the object to be moved and the undersupport therefor and preferably presents relatively good frictional engagement with the object and undersupport” and Col. 3, Lines 18-23 stating, “[w]ith particular reference to FIGS. 2 and 3, it will be recognized that the illustrated tubular mat 15 is constructed as a laminate to include an outer layer 20 of tough flexible material and preferably providing a wear-resistant exterior surface 21, productive of relatively high frictional interengagement with the object or patient to be moved and an undersupporting surface.” (emphasis added).

Berge in fact, provides a negative teaching away from the features of claim 1 and 2 in that its desired to use a high frictional material so that there is “good frictional engagement” with the patient. In contrast, claim 1 and its dependent claim 2 feature a low frictional material and claim 2 further states that the coefficient of friction is less than 0.4. Also deficient in Berge is any teaching or suggestion that a coefficient of static friction substantially the same as its coefficient of dynamic friction as featured in claim 1. Accordingly, claims 1 and 2 are in condition for allowance and a notice to that effect is respectfully requested.

The Office Action further states that Applicant discloses materials identified by DuPont product numbers T743, T749, and 98West/4. While these citings are examples of suitable materials, these materials were not commercially available prior to the Applicant’s priority date and selected based on confidential testing by the inventor and agreement with DuPont and it is not known to use the example materials as medical protection sheeting. Applicant is willing to

provide a declaration to that effect by one skilled in the art if the Examiner deems it necessary. Further, a new use of an existing product does not preclude patentability of the new use. *See for example*, MPEP § 2112.02 stating “[t]he discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using, citing *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957). *See also*, *In re Cortright*, 49 USPQ2d 1464, 1465-68 (reversing the board’s rejection of claim 1 concerning a method of treating baldness by applying a commercially known product used to soften cow udders). Accordingly, claims 1 and 2 are in condition for allowance and a notice to that effect is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103

The Office Action stated that claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berge. The features of claims 1 and 2 have been discussed above.

The Supreme Court of the United States acknowledged that rejections on obviousness grounds cannot be sustained by mere conclusory statements, and that instead, there must be some rational underpinning to support the legal conclusion of obviousness. *KSR Int’l Co. v. Teleflex*, 82 USPQ2d 1385, 1396 (2007). In particular, in to establish a *prima facie* case for obviousness, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Takeda Chemical Indus., Ltd. v. Alphapharm Pty. Ltd.*, 492 F.3d 1350, 1356-57 (Fed. Cir. 2007) *quoting KSR Int’l Co. v. Teleflex*, 82 USPQ2d 1385, 1396 (2007) (emphasis added). Not only is there no reason to use Berge, but as discussed above, Berge fails to teach or suggest all the features of claims 1 and 2. Further, Berge’s desire for the use of high frictional material in contact with the patient’s skin

results in a negative teaching, obviating a *prima facie* case of obviousness. “An applicant may rebut a *prima facie* case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect.” *In re Peterson*, 65 USPQ2d 1379, 1384 (Fed. Cir. 2003) citing *In re Geisler* 43 USPQ2d 1362, 1365 (Fed Cir. 1997). Since Berge fails to teach or suggest all the features of both claims 1 and 2, and further provides a negative teaching, claims 1 and 2 are in condition for allowance and a notice to that effect is respectfully requested.

The Office Action stated that claims 4-7, 12, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berge as applied to claims 1 and 2 above in view of U.S. Patent Publication No. 2006/0252322 to DeBenedictis *et al.*, (hereinafter “DeBenedictis”).

At the onset, it should be noted that DeBenedictis teaches a fabric for use in an air bag and that there is no reason to combine DeBenedictis with Berge’s medical mat conveyor as required under *KSR Int’l. See supra*. Both DeBenedictis and Berge are non-analogous art, not only with respect to each other, but also with respect to the claimed invention, and therefore, one skilled in the art would not have combined them and the rejection is respectfully traversed.

The CCPA (predecessor court to the Court of Appeals for the Federal Circuit) has explained the policy regarding a rejection based on the combination of non-analogous art as follows:

[i]n resolving the question of obviousness under 35 U.S.C. 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding

rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art.

In re Wood, 202 USPQ 171, 174 (C.C.P.A. 1979) (*internal citation omitted*). In addition, the Federal Circuit has clarified how to determine whether a reference is reasonably pertinent to the particular problem with which the inventor was involved. The Federal Circuit has stated that:

[a] reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem. . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

In re Clay, 23 USPQ2d 1058, 1060-1061 (Fed. Cir. 1992) (emphasis added). It is respectfully submitted that DeBenedictis' purpose of providing a fabric for forming a better air bag with better tear strength of nylon fabrics does not serve the same purpose as the present invention which provides a medical protection sheeting for covering a dressing. Accordingly, the rejection based on the obviousness combination of DeBenedictis and Berge is respectfully inappropriate.

Despite the improper combination of non-analogous art, if combined, Berge as discussed above, fails to teach or suggest all the features of claim 1 and the addition of DeBenedictis fails to cure such deficiency. As already discussed, Berge desires a high friction material to be in contact with the patient, and Berge along with DeBenedictis are both completely void of a low frictional material having a coefficient of static friction substantially the same as its coefficient of

dynamic friction as featured in claim 1.

In addition, claims 4-7, 12, 14, and 15 depend either directly or indirectly from nonobvious claim 1 (for the reasons discussed above) and are allowable as a result of their dependency and because of their own distinctive features. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (stating that if an independent claim is nonobvious, then any claim depending therefrom is nonobvious). Accordingly, claims 4-7, 12, 14, and 15 are in condition for allowance and a notice to that effect is respectfully requested.

The Office Action stated that claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berge as applied to claim 1 in view of U.S. Patent No. 5,176,624 to Kuehnreich (hereinafter “Kuehnreich”). The features of claim 1 have been discussed above.

Claims 8 and 9 depend either directly or indirectly from nonobvious claim 1 (for the reasons discussed above) and are allowable as a result of their dependency and because of their own distinctive features. *See In re Fine*, 5 USPQ2d at 1600. Accordingly, claims 8 and 9 are in condition for allowance and a notice to that effect is respectfully requested.

The Office Action stated that claims 16-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuehnreich. Claim 16 features a boot for covering a medical dressing located on a patient’s foot comprising a housing for enveloping a foot, a first and second end located about the housing such that the first end is enclosed forming a toe and the second end includes an opening for receiving a foot. The boot covering further comprises a collar surrounding the opening at the second end and an external seam securing the housing of the boot from the first end to the second end. The boot includes a slice extending from the opening at the second end to a midsection of the boot. A plurality of straps encompasses the slice for

substantially closing and securing the slice about a foot. The boot further comprises a medical protection sheeting making up the material for the housing, wherein the sheeting is formed from a low frictional material having a coefficient of static friction substantially the same as its coefficient of dynamic friction. Claim 16 was briefly discussed during the interview, however, no agreement was reached regarding its allowability.

Nowhere does Kuehnreich teach or suggest a boot comprising a medical protection sheeting making up the material for the housing, wherein the sheeting is formed from a low frictional material having a coefficient of static friction substantially the same as its coefficient of dynamic friction as featured in claim 16. Instead, Kuehnreich teaches away from use of a low frictional material and instead teaches use of an elastic bandage material. *See* Col. 3, Lines 60-61. Elastic bandage material is considered to be a material having properties of high friction and Applicant is willing to provide a declaration to that effect by one skilled in the art if the Examiner deems it necessary. Furthermore, the elastic bandage material used in Kuehnreich would be unsuitable for covering a medical dressing as claimed because it would cause a snatching or jerking action when relative movement occurs at a static and dynamic coefficient of friction stage and would result in damage to the underlying skin of the patient. Since Kuehnreich fails to teach or suggest all the features of 16, and further provides a negative teaching, claims 16 is in condition for allowance and a notice to that effect is respectfully requested.

Claims 17-22 depend either directly or indirectly from nonobvious claim 16 (for the reasons discussed above) and are allowable as a result of their dependency and because of their own distinctive features. *See In re Fine*, 5 USPQ2d at 1600. Accordingly, claims 17-22 are in condition for allowance and a notice to that effect is respectfully requested.

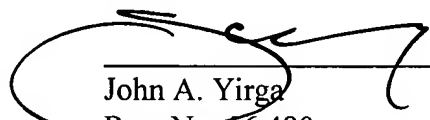
New claims 23-26 have been added and are believed to be patentable over the cited references in view of the reasons discussed above and/or because of their own distinctive features. Accordingly, claims 23-26 are in condition for allowance and a notice to that effect is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims in this Application are patentably distinct from the cited references and are in condition for allowance. Prompt notice to that effect is respectfully requested. If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 20-0090 for additional fees required under 37 C.F.R. §§ 1.16, 1.17; particularly extension of time fees.

Respectfully submitted,

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